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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,678	06/18/2001	Albrecht Schneider	P06568US01/MP	7203

881 7590 09/13/2002

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EXAMINER

WILLIAMS, KEVIN D

ART UNIT PAPER NUMBER

2854

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/881,678

Applicant(s)

SCHNEIDER, ALBRECHT

Examiner

Kevin D. Williams

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's election of Group II, claims 12-24 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is repeated here and made final.

### ***Claim Objections***

2. Claims 12-24 are objected to because of the following informalities:

The limitation "the workpiece support table" lacks antecedent basis in claim 12, line 5. "The other side" also lacks antecedent basis in claim 12, line 6. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-24 are rejected under 35 U.S.C. 112, second paragraph, as being ~~indefinite for failing to particularly point out and distinctly claim the subject matter which~~ applicant regards as the invention.

The language "on the side of the workpiece located opposite the marking tool" in claim 12 is unclear. It is unclear to the examiner as to where the counter-support is

located with respect to the marking tool and the workpiece. Moreover, It seems that both sides of the workpiece are located opposite the marking tool.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirate (US 5,775,215).

Hirate teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 79 and at least one counter-support 7 on the side of the workpiece located opposite the marking tool, the marking tool having a tool tip which can be pressed onto or into the workpiece against a restoring force (col. 6, lines 3-5) of an elastic element, the marking tool being fixed in place on a punch holder 77 or the holder at the workpiece support table of a punch press, where the counter-support can be fixed in place on the other side of the workpiece, an adjustable support 73 associated with the marking tool by means of which the position of the tool tip and/or the prestress of its restoring spring can be adjusted, the tip capable of penetrating the surface of the workpiece to a predetermined depth to inscribe a mark (col. 7, lines 25-30).

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6. Claims 12, 13, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Andou (US 5,474,319).

Andou teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 15 and at least one counter-support 21 on the side of the workpiece located opposite the marking tool, the counter-support including at least one rotatable support roller 21 or support ball for the movable support of the workpiece, the marking tool having a tool tip which can be pressed onto or into the workpiece against a restoring force of an elastic element 7, the marking tool being fixed in place on a punch holder 38 or the holder at the workpiece support table of a punch press, where the counter-support can be fixed in place on the other side of the workpiece, an adjustable support 45 associated with the marking tool by means of which the position of the tool tip and/or the prestress of its restoring spring can be adjusted.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. ~~Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable~~  
over Hirate in view of Canning (US 5,393,707).

Hirate teaches the claimed invention but does not mention the shape of the tool tip or from what material the tool tip is made.

Canning teaches a marking apparatus comprising a diamond tool tip 15 of conical shape.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the diamond tip as taught by Canning because of the extreme durability of diamond.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andou in view of Sawa (US 5,344,243).

Andou teaches the claimed invention except for the tool tip being selected from the group consisting of diamond, boron nitride, or a hard alloy.

Sawa teaches a marking apparatus comprising a tool tip being selected from the group consisting of diamond, boron nitride, or a hard alloy (Abs.). Sawa teaches the advantage of printing at high speeds with a tool tip made from a hard alloy.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Andou to have the tool tip as taught by Sawa in order to produce quality prints at high speeds.

10. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Rohr (US 5,188,047).

Hirate teaches the claimed invention except for the tool tip comprising a ball point, a roller point, a felt tip, or a grease pencil.

Rohr teaches a marking apparatus comprising a tool tip comprising a ball point, a roller point, a felt tip, or a grease pencil (78).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the writing utensil as taught by Rohr, in order to mark workpieces with identifying indicia that does not damage the surfaces of the workpieces.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Keller (US 6,164,203).

Hirate teaches the claimed invention except for the marking tool comprising plastic or brass.

Keller teaches a marking apparatus comprising plastic or brass (col. 12, line 44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the marking apparatus comprise plastic as taught by Keller, in order to utilize an inexpensive yet durable material.

### ***Allowable Subject Matter***

12. Claims 14-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

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The primary reason for the indication of the allowability of claim 14 is the limitation of the marking tool including rotatable support rollers or support balls seated in an elastically spring-loaded manner for supporting the workpiece in combination with the other claimed subject matter.




**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (703) 305-3036. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-4399 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

KDW  
September 9, 2002

  
ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800

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